



AV-1/2008
Docket No. AM9-98-146

In re application of: Joseph Gutman et al.
Serial No.: 09/502,923
Filed: February 11, 2000
For: *PORTABLE PERSONAL RADIO
SYSTEM AND METHOD*

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

Transmitted herewith, in triplicate, is Appellants' Brief in support of their appeal to the Board of Patent Appeals and Interferences from the decision dated September 16, 2003 of the Examiner finally rejecting claims 1-36 of the above-referenced application.

- ☐ A petition for extension of time is enclosed.
- ☒ The Commissioner is hereby authorized to charge payment in the amount of \$ 330.00 to cover the filing fee to Deposit Account No. 09-0441.
- ☒ The Commissioner is hereby authorized to charge payment in the amount of \$ _____ to cover the extension fee to Deposit Account No. 09-0441.
- ☒ The Commissioner is hereby authorized to charge payment of any necessary fees associated with this communication, or credit any overpayment, to Deposit Account No. 09-0441.

Respectfully submitted,

Date: April 16, 2004

By: Jose Gutman

Jose Gutman

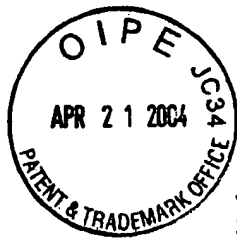
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PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Joseph GEBIS et al.
Serial No.: 09/502,923
Group Art Unit: 2685
Filed: February 11, 2000
Examiner: Pablo N. TRAN
For: PORTABLE PERSONAL RADIO
SYSTEM AND METHOD

CERTIFICATE OF MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patent, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
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APPELLANT'S BRIEF UNDER 37 C.F.R. §1.192

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Commissioner for Patents
P.O. Box 1450
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Sir:

This Appellant's Brief is filed in response to a Final Office Action dated September 16, 2003 and a Notice of Appeal filed February 17, 2004. Reconsideration of the Application, withdrawal of the rejections and allowance of the claims are respectfully requested.

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I. REAL PARTY IN INTEREST

The real party in interest is International Business Machines (IBM) of Armonk, NY.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-36 are pending. Claims 1-36 were finally rejected in the Office Action dated September 16, 2003. Claims 1-36 are on appeal.

Attached hereto is an Appendix containing a copy of claims 1-36 (in their current form), which are the claims involved in this appeal.

IV. STATUS OF AMENDMENTS

The Examiner issued a non-final office action on April 10, 2003. Appellants filed a response to that non-final Office Action on July 10, 2003. The Examiner issued a final rejection of claims 1-36 in the Final Office Action of September 16, 2003. An after final amendment was filed on November 13, 2003 amending the claims and submitting remarks. This amendment was retransmitted to the Examiner on December 17, 2003 and the Examiner refers to this filing by the December 17, 2003 date. The Examiner issued an advisory action on January 22, 2004 indicating that this after-final amendment was not entered. The advisory action contained an explanation as to why the Appellants' amendment and remarks within the November 13/December 17, 2003 response did not place the application in condition for allowance.

The currently pending claims in this case are the claims as amended by the Appellants' July 10, 2003 response with amendment.

V. SUMMARY OF THE INVENTION

The presently claimed invention is directed to a method and system for an information handling system that receives information relating to a subscriber

personal profile comprising subscriber content preferences. Specification, page 12, line 26 through page 13, page 19. The method and system further fetches content from a content database according to the subscriber content preferences, wherein the fetched content is organized into at least one channel. Specification page 17, line 17 through page 18, line 9. The content from the at least one channel is mixed into a stream of data according to the subscriber personal profile comprising subscriber content preferences. The stream of data is transmitted for receipt by a remote subscriber unit via a wireless medium for audio rendering to a user. Various embodiments of the present invention also include mixing and/or combining multiple channels for transmission. Further embodiments allow a channel to interrupt a default channel. Other embodiments play different channels through different speakers of a receiver. Specification, page 6, lines 11-26. Yet further embodiments provide a text-to-audio converter in the remote subscriber for converting textual content to audio content that can be heard by the user. Specification, page 5, lines 10-13.

VI. ISSUES

Whether claims 1-8, 12-19, 23-30 and 34 are anticipated under 35 U.S.C. §102(e) by *Cannon et al* (Cannon).

Whether claims 9-11, 20-22, 31-33, and 35-36 are unpatentable under 35 U.S.C. §103(a) over *Cannon et al* (Cannon).

VII. GROUPING OF CLAIMS

Group I: Claims 1-8, 12-19, and 23-30 stand or fall together.

Group II: Claims 9, 20, and 31 stand or fall together.

Group III: Claims 10, 21, and 32 stand or fall together.

Group IV: Claims 11, 22, and 33 stand or fall together.

Group V: Claim 34.

Group VI: Claims 35 and 36 stand or fall together.

VIII. ARGUMENT

A. WHETHER CLAIMS 1-8, 12-19, 23-30 AND 34 ARE ANTICIPATED UNDER 35 U.S.C. §102(e) BY CANNON ET AL.

In the Examiner's Office Action of March 10, 2003, the Examiner rejected claims 1-8, 12-19, 23-30 and 34 under 35 U.S.C. § 102(e) as being anticipated by Cannon. Appellant respectfully submits that claims 1-8, 12-19, 23-30 and 34 are patentable under 35 U.S.C. § 102(e) over Cannon because Cannon does not teach the claimed limitations of: 1) content [that] is organized into at least one channel; and 2) a client radio system comprising a text-to-audio converter for converting textual content to audio content.

Group I (claims 1-8, 12-19, and 23-30)

Appellants respectfully assert that the Group I claims distinguish over the prior art of record. Appellants suggest using independent claim 1 as a representative claim for this group. Claim 1 is directed towards an information handling system that includes "a content database for storing content, wherein the content is organized into at least one channel." As discussed below, Cannon does not teach, suggest or make obvious this claimed limitation. I

To begin, Cannon is directed to coupling a selective call receiver to widely distributed information sources. Cannon teaches selecting and formatting information from different sources based upon various considerations, including a user profile (Cannon, Column 2, lines 51-67, Column 3, lines 1-12). Cannon further teaches specifying criteria by which to search for information that is sent to the user. (Cannon, Column 3, lines 13-14).

Appellants note that there is a possible point of confusion between channels as discussed in the Cannon reference and the channels of the appellants' claimed invention. Cannon discusses an ability of the user to control message routing over various communications channels to the same or different devices. Cannon, Column 3, lines 30-40. Cannon discusses delivering "information back to the user, using the same channels that the user used to get to the agent." Cannon, Column 3, lines 34-35. Cannon then goes on to discuss

an alternative of delivering information elsewhere, such as allowing the user to specify a facsimile number or e-mail address. It is clear that the term "channel" as used by Cannon refers to a communications channel, such as a radio frequency channel or wire-line data communications channel. In contrast to *Cannon*, the claimed elements of the Appellants' invention use the term "channel" as an entity into which "content is organized" See, Claim 1.

Separately, the Examiner's Response to Arguments in the Final Office Action dated September 16, 2003, apparently states that "Channel" of the presently claimed invention is similar to the "Source" that is taught in *Cannon*. Appellants respectfully point out that the term "Source" as used in *Cannon* describes a source of information. For example, *Cannon* describes "various sources, such as different web pages[.]" *Cannon*, Column 2, line 59. These sources, which are external to the server of *Cannon*, are then searched for information by the search function that is taught by *Cannon*. This information is then sent to pager subscribers. In contrast to *Cannon*, the present invention describes "channels" as "streams of data," as in the case of "when a new stream of data is sent from the server 14 (either when the system first starts or when the channel is changed)." Specification, page 9, lines 1-2 (Emphasis added). That is, the server of the exemplary embodiments of the present invention store channels of information and information from these stored channels are then sent to subscribers.

With regards to a limitation recited in Claim 1 of "a content database for storing content, wherein the content is organized into at least one channel[.]" *Cannon* does not teach a content database that organizes content into at least one channel. The examiner cites a portion of *Cannon* that states "a server for retrieving user selected information from a widely distributed information source." Appellants respectfully assert that "retrieving information from a widely distributed information source," as is taught by *Cannon*, is not the same as a "content database for storing content, wherein the content is organized into at least one channel[.]" as is claimed by the present invention. The "widely distributed information source" of *Cannon* includes "different web pages. *Cannon*, column 2,

lines 58-60. In contrast, the present invention stores, in a database, content that is organized into channels. See Specification, Figure 3, page 5, line 23 through page 6, line 26.

In contrast to the claimed elements of the present invention, Cannon only teaches an "ability to dynamic (sic) parse and customize information that would be delivered to a user." Cannon, column 2, lines 52-53 (Emphasis added). This customization is based on various information, such as channel capacity and cost. Cannon, column 2, lines 53-57. This teaching by Cannon, whereby information is dynamically parsed as it is delivered to the user, is in stark contrast to content "organized into at least one channel" as is claimed by the Group I claims.

Appellants point out that "parsing" as is taught by Cannon is a means of selecting the amount of information (i.e., a subset of information) that is obtained and extracted from external sources that is then to be delivered to users. For example, when channel capacity is limited and/or channel delivery cost is high, it is possible to reduce the information to be transmitted and thereby conserve resources. Such "parsing" then increases operational efficiency by causing a minimum amount of information (i.e., data) to be delivered when capacity is low and/or costs are high. The operation of this parsing further allows more information to be transmitted when capacity is high and/or costs are low, thereby allowing the user to benefit from more information when delivery capacity and/or costs are better able to support such increased information transfers.

Group V (claim 34)

Appellants respectfully assert that Claim 34, i.e., the Group V claim, distinguishes over the prior art of record. Claim 34 is directed towards an information handling system that "comprises a client radio system comprising a text-to-audio converter for converting textual content to audio content." The invention claimed by claim 34 has the text-to-audio converter in the remote subscriber unit. In contrast to the claimed invention, Cannon teaches a text-to-audio converter that is part of the server, so that a voice-audio over-the-air

protocol can be used. The claimed invention's use of a text-to-audio converter in the remote subscriber unit advantageously allows text data to be transmitted to the remote subscriber unit. Transmission of text to the remote subscriber unit in this aspect of the present invention results in the transmission of less data that is required to transmit the voice data directly, as is taught by the Cannon reference.

Additionally, claim 34 depends from independent claim 1 that is contained within the Group I claims. For at least the reasons discussed above for Group I, claim 34 also distinguish over Cannon.

B. WHETHER CLAIMS 9-11, 20-22, 31-33, and 35-36 ARE UNPATENTABLY UNDER 35 U.S.C. §103(a) OVER CANNON ET AL.

In the Examiner's Office Action of September 16, 2003, the Examiner rejected claims 9-11, 20-22, 31-33 and 35-36 under 35 U.S.C. § 103(a) as being unpatentable over Cannon. Appellant respectfully submits that claims 9-11, 20-22, 31-33 and 35-36 are patentable under 35 U.S.C. § 103(a) over Cannon because Cannon does not teach the claimed limitations of: 1) allowing the user to specify the way that the content from the plurality of channels is combined when delivered to the user; 2) allowing the user to specify updates of specified information to be presented to the user by interrupting the default channel being presented to the user; 3) allowing the user to specify that combined information from multiple channels of information be presented simultaneously to the user; and 4) a subset of the mixed information from multiple channels is sent to one of a plurality of speakers.

Group II (claims 9, 20 and 31)

Appellants respectfully assert that the Group II claims distinguish over the prior art of record. Appellants suggest using dependent claim 9 as a representative claim for this group. Claim 9 is directed towards an information handling system that comprises "personalized channel mixing means for allowing a user to specify the way that the content from the plurality of channels is combined when delivered to the user." As noted by the Examiner, Cannon does

teach that time variable information is able to be formatted in different ways based upon such things as channel capacity or cost. The Cannon system is implemented in a selective call transceiver, such as a paging environment, wherein peak transmission periods, such as rush hours, place a premium on transmission of information without delay. Some paging systems might increase transmission charges to discourage transmissions during these peak periods, thereby creating a user preference to restrict timing due to costs. Appellants submit that such reformatting does not teach or make obvious the claimed aspects of the present invention, which include user configurable mixing or combining of information or content as is claimed for aspects of the present invention by dependent claims 9, 20 and 31. There is just no teaching or suggestion in the Cannon reference of simultaneous delivery of information as is claimed by the present invention. Appellants respectfully reassert that the Examiner's statement of a motivation to include the limitation found only in the Appellants' invention is not sufficient to establish *prima facie* obviousness in the combination of elements claimed by the Appellants. As has been repeatedly held:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). I

MPEP §2143.03 (Emphasis added)

Furthermore, when there is no suggestion or teaching in the prior art user configurable mixing or combining of information or content, the suggestion can not come from the Applicant's own specification. As the Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

Additionally, the Group II claims depend from the independent claims contained in Group I. For at least the reasons discussed above for Group I, the Group II claims also distinguish over Cannon.

Group III (claims 10, 21 and 32) and Group IV (claims 11, 22 and 33)

Appellants respectfully assert that the Group III claims distinguish over the prior art of record. Appellants suggest using independent claim 10 as a representative claim for this group. Claim 10 is directed towards an information handling system with personalized channel mixing means that comprises "alert mixing means for the user to specify updates of specified information from a first channel to be transmitted by interrupting information from a default channel being transmitted." This results in the mixing of content by interrupting a default channel with specified information.

IV

Appellants respectfully assert that the Group IV claims distinguish over the prior art of record. Appellants suggest using independent claim 11 as a representative claim for this group. Claim 11 is directed towards an information handling system that comprises constant mixing means for the user to specify that mixed information from multiple channels be transmitted to be played simultaneously at the remote subscriber unit." This aspect of the present invention results in the mixing of content by simultaneously playing multiple channels of information to the user.

The aspects of the present invention claimed by the Group III and Group IV claims are valuable advantages of the presently claimed invention that are not taught, or suggested by any of the cited prior art. The originally filed specification includes descriptions of the advantages of channel mixing. For example:

The PPR allows the user to specify the way that information from different sources is combined when it is delivered. One form of channel mixing is alert mixing: the user is able to specify that updates of a certain type (for example, sports scores, traffic or weather that will affect the user, or large changes in the user's

stock values) would be able to interrupt the default channel the user is listening to (for example, a music channel). This allows the user to derive the benefit of listening to personalized information channels, but permits the user to listen and to automatically switch back to another channel when there is not a crucial information update. Another form of channel mixing is constant mixing: the user is able to specify that multiple sources of information both be played (for example, sports game highlights and a music channel). These sources can both be mixed to every speaker, or different sources could be sent to different speakers (for example, one source is played on the front speakers, and another is played on the rear speakers). Alert mixing is similar to severe weather warnings on televisions (except that the sources and frequency of updates is specified by the user), and constant mixing is somewhat similar to picture-in-picture on televisions

Specification, page 6 lines 11-26. These aspects of the present invention are not taught, suggested or made obvious by the cited references, since mixing of information that is organized in channels for delivery and presentation to a user is not discussed in the cited references. As noted above, "all the claim limitations must be taught or suggested by the prior art" and "all words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP §2143.03 (Emphasis added)

Additionally, the Group III and Group IV claims depend from the independent claims contained in Group I. For at least the reasons discussed above for Group I, the Group III and Group IV claims also distinguish over Cannon.

Group VI (claims 35 and 36)

Appellants respectfully assert that the Group VI claims distinguish over the prior art of record. Appellants suggest using dependent claim 35 as a

representative claim for this group. Claim 35 is directed towards an information handling system that comprises "mixing means for the user to specify that mixed information from multiple channels be transmitted to be played simultaneously at the remote subscriber unit" and "wherein a subset of the mixed/combined information from multiple channels is sent to one of a plurality of speakers." The Examiner cites a portion of Cannon that only discusses converting text information into voice signals at the server and transmitting this voice information to a subscriber unit for audio playback. The cited portion of Cannon reads:

Thus, if a particular TENOR™ subscriber unit only had voice capability and the source of information was only available in text, the agent at the server would include a text to speech converter or translator allowing for audible "viewing" of the text.

Cannon, Column 4, lines 25-30. (Emphasis added).

In contrast to the claimed invention, the Appellants respectfully submit that Cannon does not mention a plurality of speakers. As discussed above, Cannon also does not mention a mixed or combined audio or even voice signal. Appellants respectfully assert that it is improper to assert an obviousness rejection when the Appellants' disclosure provides the only teaching of the claimed elements of the rejected claims. As noted above, "all the claim limitations must be taught or suggested by the prior art" and "all words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP §2143.03 (Emphasis added).

Additionally, the Group VI claims depend from the independent claims contained in Group I. For at least the reasons discussed above for Group I, the Group VI claims also distinguish over Cannon.

IX. CONCLUSION

As discussed above, the cited prior art does not teach or suggest the elements claimed for the present invention. Specifically, the cited prior art does not teach or suggest:

- I) content organized into at least one channel;
- II) allowing a user to specify the way that the content from the plurality of channels is combined when delivered to the user;
- III) mixing of content by interrupting a default channel with specified information;
- IV) mixing content by simultaneously playing multiple channels of information;
- V) a client radio system comprising a text-to-audio converter for converting textual content into audio content; or
- VI) a subset of the mixed/combined information from multiple channels is sent to one of a plurality of speakers.

Furthermore, as is also discussed above, the Examiner's rejection of some claims is based upon improper characterizations of the cited prior art reference.

For the reasons stated above, Appellant respectfully contends that each claim is patentable. Therefore, reversal of all rejections is courteously solicited.

Respectfully submitted,

Dated: April 16, 2004

By: _____

A handwritten signature in black ink, reading "Jose Gutman". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

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X. APPENDIX

1. An information handling system, comprising:

a content database for storing content, wherein the content is organized into at least one channel;

means for receiving information relating to a subscriber personal profile comprising subscriber content preferences, wherein the subscriber content preferences comprise preferences for at least one preferred channel within the at least one channel;

a content controller for selecting content from the at least one preferred channel according to the subscriber content preferences;

means for mixing content from the at least one preferred channel according to the subscriber personal profile comprising subscriber content preferences;

a modulator coupled to the text-to-audio converter for modulating audio content to provide audio-modulated signals; and

a transmitter coupled to the content database and to the means for mixing content for transmitting mixed content from the at least one preferred channel to a remote subscriber unit via a wireless link.

2. The system of claim 1, wherein the transmitter is a radio-frequency transmitter.

3. The system of claim 1, wherein the transmitter operates under an analog cellular telephone protocol.

4. The system of claim 1, wherein the transmitter operates under a digital cellular telephone protocol.

5. The system of claim 1 wherein the subscriber content preferences are provided by a user of the remote subscriber unit via the wireless link, thereby identifying personal preferences.

6. The system of claim 1 wherein the subscriber content preferences comprise music.

7. The system of claim 1 wherein the subscriber content preferences comprise information relating to a stock market.

8. The system of claim 1 wherein the subscriber content preferences comprise information relating to sports.

9. The system of claim 1 further comprising personalized channel mixing means for allowing a user of the remote subscriber unit to specify the way that content from the at least one preferred channel is combined when transmitted by the transmitter.

10. The system of claim 9 wherein the personalized channel mixing means comprise alert mixing means for the user to specify updates of specified information from a first channel to be transmitted by interrupting information from a default channel being transmitted.

11. The system of claim 9 wherein the personalized channel mixing means comprise constant mixing means for the user to specify that mixed information from multiple channels be transmitted to be played simultaneously at the remote subscriber unit.

12. A method for a personal radio system comprising the steps of:
- receiving information relating to a subscriber personal profile comprising subscriber content preferences;
 - fetching content from a content database according to the subscriber content preferences, wherein the fetched content is organized into at least one channel;
 - mixing content from the at least one channel into a stream of data according to the subscriber personal profile comprising subscriber content preferences; and
 - transmitting the stream of data for receipt by a user unit via a wireless medium for audio rendering to a user of the user unit.
13. The method of claim 12 further comprising converting the fetched content from text to audio and modulating a carrier signal with the audio for transmission to the user.
14. The method of claim 12 further comprising transmitting a radio-frequency signal with the audio to the user.
15. The method of claim 12 further comprising transmitting a signal with the audio using an analog cellular telephone protocol.
16. The method of claim 12 further comprising transmitting a signal with the audio using a digital cellular telephone protocol.
17. The method of claim 12 wherein the subscriber content preferences comprise music.
18. The method of claim 12 wherein the subscriber content preferences comprise information relating to a stock market.

19. The method of claim 12 wherein the subscriber content preferences comprise information relating to sports.

20. The method of claim 12 wherein the at least one channel comprises a plurality of channels and wherein the method further comprises allowing the user to specify the way that the content from the plurality of channels is combined when delivered to the user.

21. The method of claim 20 further comprising allowing the user to specify updates of specified information to be presented to the user by interrupting a default channel being presented to the user.

22. The method of claim 20 further comprising allowing the user to specify that combined information from multiple channels of information be presented simultaneously to the user.

23. A computer-readable medium for a personal radio system comprising the instructions for:

- receiving information relating to a subscriber personal profile comprising subscriber content preferences;

- fetching content from a content database according to the subscriber content preferences, wherein the fetched content is organized into at least one channel;

- mixing content from the at least one channel into a stream of data according to the subscriber personal profile comprising subscriber content preferences; and

- transmitting the stream of data for receipt by a user unit via a wireless medium for audio rendering to a user.

24. The medium of claim 23 further comprising instructions for converting the fetched content from text to audio and modulating a carrier signal with the audio for transmission to the user unit.

25. The medium of claim 23 further comprising instructions for transmitting a radio-frequency signal with the audio to the user unit.

26. The medium of claim 23 further comprising instructions for transmitting a signal with the audio using an analog cellular telephone protocol.

27. The medium of claim 23 further comprising instructions for transmitting a signal with the audio using a digital cellular telephone protocol.

28. The medium of claim 23 wherein the subscriber content preferences comprise music.

29. The medium of claim 23 wherein the subscriber content preferences comprise information relating to a stock market.

30. The medium of claim 23 wherein the subscriber content preferences comprise information relating to sports.

31. The medium of claim 23 wherein the at least one channel comprises a plurality of channels and wherein the medium further comprises instructions for allowing the user to specify the way that information from different channels is combined in the transmitted stream of data.

32. The medium of claim 31 further comprising instructions for allowing the user to specify updates of specified information to be presented to the user by interrupting the default channel being presented to the user.

33. The medium of claim 31 further comprising instructions for allowing the user to specify that content from multiple channels of information be presented simultaneously to the user.

34. The system of claim 1, further comprising a client radio system comprising a text-to-audio converter for converting textual content to audio content.

35. The system of claim 11, wherein a subset of the mixed information from multiple channels is sent to one of a plurality of speakers.

36. The method of claim 22, wherein a subset of the combined information from multiple channels is sent to one of a plurality of speakers.